REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 112, comply with 35 U.S.C. § 101, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, <u>the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits</u>.**

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 112

Claims 62 and 63 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner concluded that these claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the

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claimed invention, and further concluded that these claims added new matter. Specifically, the Examiner contends that the recitation the acts of "'the method are performed automatically, without the need for user intervention' has not been found in the instant specification." (See Paper No. 20080226, page 3.)

Although the applicants agree that the proper test for determining compliance with the written description requirement is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicants were in possession of the claimed invention, the applicants respectfully note that, "[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." (MPEP 2163.02)

The acts of the method of claim 46 are supported, for example, inherently by Figure 10, which is an example 930' of the duplicate removal management process 930 of Figure 9. Referring to Figure 9, the duplicate removal management process 930 is part of an example 734' of the query processing process 734 of Figure 7. The query processing process 734 of Figure 7 is part of a search facility server 730. Section 4.3.2 of the specification describes exemplary machines 1300 for performing such processes. In this regard, the specification describes that "processor(s) 1310 [that] may execute machine-executable instructions … to effect one or more aspects of the present invention." (Page 31, lines 25-31) The specification further describes:

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Some aspects of the present
invention may be effected in the
general context of computer-executable
instructions, such as program modules,
being executed by a personal computer.

Program modules may include routines,
programs, objects, components, data
structures, etc. that perform a task(s)
or implement particular abstract data
types.

(Page 32, lines 5-13) With regard to the fact that the

acts of the method can be performed automatically,

without user intervention, the specification states:

A user may enter commands and
information into the personal computer
through input devices 1332, such as a
keyboard and pointing device (e.g., a
mouse) for example. Other input
devices such as a microphone, a
joystick, a game pad, a satellite dish,
a scanner, or the like, may also (or
alternatively) be included. These and
other input devices are often connected
to the processing unit(s) 1310 through
a serial port interface 1330 coupled to
the system bus 1340. Input devices may
be connected by other interfaces 1330,
such as a parallel port, a game port or
a universal serial bus (USB). *However,
in the context of a search facility
730, no input devices, other than those
needed to accept queries, and possibly
those for system administration and
maintenance, are needed*. [Emphasis
added.]

(Page 33, line 30 through page 34, line 11)

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The applicants respectfully submit that at least the foregoing portions of the application demonstrate compliance with the written description requirement with respect to claims 62 and 63 because these sections, either taken alone or in the context of the rest of the application, reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Therefore, the applicants respectfully request that the Examiner withdraw this ground of rejection.

In response, the Examiner has quoted a portion of the description of Figure 10, which merely notes that the method 930' of Figure 10 **may be repeated to process a next group of results if requested by a user**. This statement would not lead one skilled in the art to believe that the method 930' of Figure 10 is not an automated process, nor would it lead one skilled in the art to believe that something that **may** be done, **must** be done, precluding other implementations. More specifically, the specification makes clear to one skilled in the art that the acts recited in claim 46 (and the operations of the elements recited in claim 51) can occur **after** receipt of a search query and **before** a possible user request **to process and provide a next group of search results**. Thus, the application reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

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Rejections under 35 U.S.C. § 101

Claims 49, 50, 57 and 58 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Since these claims have been amended to recite apparatus including at least one storage device storing processor executable instructions and at least one processor for executing such instructions, these claims now recite statutory subject matter.

Rejections under 35 U.S.C. § 102

Claims 46-52, 54, 55, 57, 58, 60, 61 and 64-71 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the paper Zamir, "Clustering Web Documents: A Phrase-Based Method for Group Search Engine Results," pp. 1-208 (1999, University of Washington) ("the Zamir paper"). The applicants respectfully request that the Examiner reconsider and withdraw this rejection in view of the following.

Independent claim 46 is not anticipated by the Zamir paper at least because the Zamir paper does not teach a method including generating a set of final search results from the search results that were received, the act of generating being performed by using one or more segments of the search results, *wherein each of the one or more*

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segments used includes at least one of the one or more keywords.

The Examiner cites an example of the act of refining a search query discussed on page 125 and illustrated in Figure 5.4 of the Zamir paper as teaching this feature. (See Paper No. 20080226, page 5.) The applicants respectfully disagree because this example merely shows that the method espoused by the Zamir paper *might*, in some instances, generate (as suggested refined queries) phrases that happen to include keywords of the original search query. However, this example does not demonstrate that the method espoused by the Zamir paper *necessarily, consistently and inevitably* produces (as suggested refined queries) phrases that include keywords of the original search query. Indeed, some of the phrases that the user can select to refine the query need not include any of the keywords of the original search query, as demonstrated below.

Referring first to Figure 5.2, a "main results page" to the query "clinton" includes three "cluster" results. Each of the results may include:

> the size the of the cluster, *shared phrases – phrases that appear in many documents of the cluster*, and up to three *sample titles* of documents in the cluster. The numbers appearing in parenthesis after each phrase indicate the percentage of the documents in the cluster that contain the phrase. [Emphasis added.]

(Zamir paper, page 122) Figure 5.3 shows more detailed information for the first cluster, and provides an option to "Refine [The] Query Based On This Cluster." (Zamir

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paper, pages 124 and 125)   Finally, Figure 5.4 shows the
query refinement page provided if the foregoing option is
selected by a user.   Note that at least some of the
phrases provided (specifically, "Monica Lewinsky" and
"Kenneth Starr Investigation") do not **include at least
one of the one or more keywords** from the original query
("clinton").   Although some of the other "shared phrases"
included the original query term "clinton", **since such
"shared phrases" do not necessarily, consistently and
inevitably include keywords from the original query, any
accidental achievements of the claimed process** (that is,
any "shared phrases" including a keyword from the
original search query) **do not constitute an anticipation**.
The applicants respectfully note that it is well
established that an anticipatory inherent feature or
result must be consistent, necessary, and inevitable, not
merely possible or probable.

As can be appreciated from the foregoing, the
example illustrating the "refine query" operation
described in the Zamir paper and cited by the Examiner
does not teach the claimed act of generating a set of
final search results from the search results that were
received, the act of generating being performed by using
one or more segments of the search results, **wherein each
of the one or more segments used (consistently,
necessarily and inevitably) includes at least one of the
one or more keywords** (which keywords were included in the
query, on which the original set of search results was
based).   Thus, independent claim 46 is not anticipated by
the Zamir paper for at least this reason.   Independent
claims 49 (as amended) and 51 are similarly not
anticipated by the Zamir paper.   Since claims 47, 48, 54,

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55 and 64-67 depend from claim 46, since claims 50, 57 and 58 depend from claim 49 and since claims 52, 60, 61 and 68-71 depend from claim 51, these claims are similarly not anticipated by the Zamir paper.

Before addressing various features of some of the dependent claims, the applicants first note that to anticipate a claim, the reference must teach every element of the claim and *"[t]he elements must be arranged as required by the claim..."* (MPEP 2131) More specifically, the Court of Appeals for the Federal Circuit ("the CAFC") has instructed that to anticipate, a single prior art reference must "describe all of the elements of the claims, *arranged as in the [claim].*" (Emphasis added.) C.R. Bard Inc. v. M3 Systems, Inc., 48 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). This is in accord with previous Court of Claims and Patent Appeals ("the CCPA") decisions. For example, the CCPA has instructed that to anticipate:

> [the] reference must *clearly and unequivocally* disclose the claimed [invention] or direct those skilled in the art to the [claimed invention] *without any need for picking, choosing and combining various disclosures not directly related to each other* by the teachings of the cited reference. [Emphasis added.]

In re Arkley, 172 U.S.P.Q. 524, 526 (CCPA 1972).

In rejecting some of the dependent claims, the Examiner impermissibly combines different teachings of different techniques in a way not taught or suggested by the Zamir paper. More specifically, the Zamir paper proposes a "suffix tree clustering" approach to provide

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search results to a user query. A portion of the Zamir paper cited by the Examiner pertains to the suffix tree clustering approach, while another portion of the Zamir paper cited and relied on the by the Examiner concerns "single-pass" clustering algorithms (See pages 29 and 30 of the Zamir paper, and page 6 of Paper No. 20080226.), while yet another portion of the Zamir paper cited and relied on by the Examiner concerns a "frequent set clustering" (FSC) algorithm, the performance of which was compared with that of the suffix tree clustering (STC) approach (See pages 101-106 of the Zamir paper, and pages 5 and 6 of Paper No. 20080226.)

Further regarding dependent claim 47, the Examiner relies on pages 105 and 106 of the Zamir paper as teaching the additional features of this claim. However, the cited sections of the Zamir paper concern a "frequent set clustering" (FSC) algorithm, the performance of which was compared with that of the suffix tree clustering (STC) approach. Since the Examiner picked, chose and combined various parts of the Zamir paper not directly related to each other, this rejection is improper. Consequently, dependent claim 47 is not anticipated by the Zamir paper for at least this additional reason.

Further regarding dependent claim 48, the Examiner relies on page 29 of the Zamir paper as teaching the additional features of this claim. However, the cited section of the Zamir papaer concerns "single-pass" clustering algorithms, not the suffix tree clustering (STC) algorithm. Since the Examiner picked, chose and combined various parts of the Zamir paper not directly related to each other, this rejection is improper.

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Consequently, dependent claim 48 is not anticipated by the Zamir paper for at least this additional reason.

Finally, dependent claims 66, 67, 70 and 71 further recite that the segments are sentences or paragraphs. The Examiner cites various unrelated portions of the Zamir paper as teaching sliding windows of n (or 5) words. (See Paper No. 20080226, page 7.) First, this does not teach that the claimed segments are sentences or paragraphs. Further, the Zamir paper states, "that the use of long phrases (3 words or more in length) does not add much to the quality of the results." (Zamir paper, pages 7 and 8.) Thus, dependent claims 66, 67, 70 and 71 are not anticipated by the Zamir paper for at least this additional reason.

Rejections under 35 U.S.C. § 103

Claims 62 and 63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Zamir paper. The applicants respectfully request that the Examiner reconsider and withdraw this rejection in view of the following.

The Examiner cites the "refine query" portion of the Zamir paper as suggesting performing the claimed acts of (a) receiving search results that have been generated based on a query that includes one or more keywords, (b) receiving at least one of the one or more keywords, and (c) generating a set of final search results from the search results that were received, the act of generating being performed by using one or more segments of the search results, wherein each of the one or more segments

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used includes at least one of the one or more keywords, automatically, without the need for user intervention. Specifically, the Examiner concludes that, "[i]t would have been obvious to [one] of ordinary skill in the art to conclude that the query method of Zamir is performed automatically without user intervention as exemplified by Applicant." (Paper No. 20080226, page 8.) The applicants respectfully disagree.

As discussed above, in order to refine a query, after submitting a query (e.g., "clinton"), a user must first (1) view a particular cluster by selecting the "View Results" link (See, e.g., Figure 5.2 and the last paragraph of Page 123 of the Zamir paper.), (2) select the "Refine Query Based On This Cluster" link of the subsequent page (See, e.g., Figure 5.3 and page 125 of the Zamir paper.), and (3) click a checkbox associated with phrases that were identified in the cluster (See, e.g., Figure 5.4 and page 126 of the Zamir paper.). The Examiner's argument that it would have been obvious to perform steps related to a user's ability to refine search results automatically, without user intervention, quite frankly makes no sense.

Accordingly, claims 62 and 63 are not rendered obvious by the Zamir paper for at least this reason. Further, since claims 62 and 63 depend from claims 46 and 51, respectively, and since the purportedly obvious modifications to the Zamir paper would not compensate for the deficiencies of the Zamir paper with respect to claims 46 and 51 (discussed above), claims 62 and 63 are not rendered obvious by the Zamir paper for at least this additional reason.

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New claim

New claim 72 more clearly distinguishes the claimed invention over the cited art. This claim is supported, for example, by Figures 10 and 11 and their associated description in the present application.
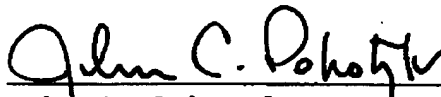
Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Respectfully submitted,

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